



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Shaughnessy J.D.

§ ART UNIT: 1642

FILED: December 04, 2003

§ EXAMINER:
§ Fetterolf, B.J.

SERIAL NO.: 10/727,461

§ CONFIRMATION NO.
§ 6235
§ DOCKET:
§ D6485

FOR: Identification of Molecular Determinants
of Myeloma Bone Disease

MS Non-Fee Amendment
Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

In response to the Examiner communication mailed May 3, 2005, Applicant hereby elects with traverse Group IV, claims 15, 16 in part, 17 in part, 18 in part and 19-25, drawn to a method of determining the risk of developing bone disease in test individual comprising examining a human homologue of Dickkopf-1 (DKK1), where the expression level is determined at the protein level.

Applicant further requests that Group III, claims 15, 16 in part, 17 in part, 18 in part and 19-25 be rejoined with Group IV, claims 15, 16 in part, 17 in part, 18 in part and 19-25 for examination. Group III is drawn to a method of determining the risk of developing bone disease in test individual comprising examining a human homologue of Dickkopf-1 (DKK1), wherein expression level is determined at the nucleic acid level. The Examiner contends that Groups IV and III are distinct since they have different mode of operation, different function

and also differ in the methodology used for detecting the different products. Applicant respectfully disagrees.

Applicant submits that although the method in Group IV is directed to examining DKK1 at the protein level and the method in group III is directed to examining DKK1 at the nucleic acid level to determine the risk of developing bone disease in a test individual, they comprise a common WNT signaling antagonist such as DKK1. Furthermore, the instant invention teaches of high levels of DKK1 protein expression in plasma cells from cases that showed high DKK1 gene expression (page 5, lines 7-17; Examples 8-11,15; Table 2). Therefore, a search for prior art related to method in Group IV would also reveal any prior art relevant to the method in Group III. Hence, the examination of Groups IV and III together will not pose a serious burden on the Examiner. Accordingly, the Applicant respectfully requests that Group IV, claims 15, 16 in part, 17 in part, 18 in part and 19-25 drawn to examination of DKK-1 at protein level be joined with Group III, claims 15, 16 in part, 17 in part, 18 in part and 19-25 drawn to examination of DKK-1 at nucleic acid level for examination.

Respectfully submitted,



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3

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Fetterolf, B.J.

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Mail Stop NON-FEE AMENDMENT
Commissioner of Patents
P.O. BOX 1450
Alexandria, VA 22313

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

Dear Sir:

I hereby certify under 37 CFR 1.8 that the following correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to Honorable Commissioner for Patents, P.O. Box 1450 Non-Fee Amendment, Alexandria, VA 22313.

- (1) Response to Restriction Requirement; (2 pages)
- (2) Return Postcard.

Please return the enclosed postcard acknowledging receipt of this correspondence.

Respectfully submitted,

Date: One 2, 2005
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